

## **REMARKS**

Claims 1-23 were pending. Claim 4 has been canceled. Claims 24-31 have been added. Claims 1, 12, 15, 17, and 23 have been amended. Accordingly, claims 1-3 and 5-31 are pending.

### **Claim Objections**

Claim 1 has been amended to overcome the objection to claims 1-4, 6, 8 and 10-11 regarding “said programmable device.” Claim 12 has been amended to overcome the objection to claims 12-15, 17 and 19-21 regarding the recitation “said data modules.” Finally, Applicant submits claim 23 does have sufficient antecedent basis for the recitation “said toy.” As noted by the Examiner, the preamble clearly recites “a programmable toy.” Nevertheless, for purposes of clarity and ease of reading, the recitation has been amended to read “said programmable toy.”

### **Claim Rejections**

#### **Regarding Paragraphs 1, 2 and 4**

In the present Office Action, claims 1-3, 8-10 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,407,779 (hereinafter “Herz”) in view of U.S. Patent No. DES 386,184 (hereinafter “Heimbürger”). In addition, claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Herz, in view of Heimbürger, and further in view of U.S. Patent No. 5,223,815 (hereinafter “Rosenthal”). Applicant respectfully traverses this rejection and submits each of claims 1, 12 and 23 are believed patentable over the cited art.

A prima facie case of obviousness of a claimed invention is not established unless (1) all the claim limitations are taught or suggested by the cited art; (2) there is some suggestion or motivation to modify a reference or combine reference teachings; and (3) there must be a reasonable expectation of success. Applicant respectfully submits such requirements are not met in this case. For example, claim 1 recites a method including “a receiving station configured to receive a broadcast signal containing program data; and a programmable device configured to be

coupled to said receiving station and to receive said program data from said receiving station; wherein one of said receiving station and said programmable device is configured to select a portion of said program data; and wherein said programmable device is configured to store said portion of said program data; wherein said receiving station is configured to transmit a notification signal to said programmable device to indicate that said receiving station is ready to transmit said program data to said programmable device, and wherein said programmable device is configured to emit a user-sensible signal to indicate that said programmable device should be brought into communication with said receiving station.” Applicant notes the above highlighted features generally correspond to those of prior claim 4.

Applicant first notes that the cited references do not teach all the features of the recited claim. For example, Herz is cited as teaching the feature “wherein said receiving station is configured to transmit a notification signal to said programmable device to indicate that said receiving station is ready to transmit said program data to said programmable device.” However, Applicant submits Herz does not teach this feature. In contrast, Herz teaches a system wherein operation may occur via RF communication or IR communication. In order to establish which mode of communication is to be used, a particular sequence of communication events are used. For example, Herz teaches:

“FIG. 6a is a flow chart showing one of the preferred methods of determining and selecting an optimal communication mode performed by the remote control system according to the present invention. At a first step (Step 601), both of the television and remote control are initialized to operate in both the radio frequency and IR mode. Then, in Step 602, the television set sends out both (1) a test enable signal; and (2) an IR request to the remote control. According to this embodiment, the test enable signal is sent by the television set using the radio frequency transceiver to inform the remote control of the incoming IR request. . . . In addition, the IR request is sent by the television set using the IR transceiver. . . . When the remote control receives the test enable signal from the television (Step 603), it proceeds to the next step, Step 604. If the remote control does not receive the test enable signal, the remote control is out of the radio frequency range of the television set so that the television set will repeat the initialization process again. In the next step (Step 604), the remote control examines whether the IR request signal is received. If the remote control does not receive the IR request signal, the remote control will not transmit any response to the television set. On the other hand, after the remote control receives the IR request sequence of data bits, the remote

control compares the received IR request sequence of data bits with a reference of the sequence of data bits stored in the remote control (Step 605). If the two sequences of data bits match, the remote control then sends an infrared acknowledgment back to the remote control (Step 606). On the other hand, if the two sequences of data bits do not match, the remote control will not send an acknowledgment sent to the television. Finally, when the television receives the IR acknowledgment signal from the remote control (Step 607), the television will set the communication mode to the IR mode (Step 608). On the other hand, if the television does not receive any IR acknowledgment after a predetermined period of time, the television will determine that the infrared channel cannot be established and will select the radio frequency mode for communication between the television and the remote control (Step 609).” (Herz, col. 7, lines 14-57) (emphasis added).

Therefore, Herz teaches a test enable signal and IR request are sent from the television to the remote control. The purpose of the test enable signal is to “to inform the remote control of the incoming IR request.” The purpose of the IR request is to determine whether IR communication is possible. If the IR request is not accurately received, then RF communication is selected as the mode of communication. Otherwise, IR communication is selected as the mode of communication. Consequently, Herz does not teach transmitting a notification signal to said programmable device to indicate that said receiving station is ready to transmit said program data to said programmable device. Also cited is Herz, col. 14, lines 56-65. However, this cited teaching of Herz merely states that a check may be performed as to whether or not the remote control is within range and does not teach the above recited feature. This statement of Herz is merely a general statement of the method which is more fully detailed in the above provided description (col. 7, lines 14-57) related to Fig. 6a.

In addition to the above, Rosenthal is cited as teaching the feature “wherein said programmable device is configured to emit a user-sensible signal to indicate that said programmable device should be brought into communication with said receiving station.” However, Applicant respectfully submits Rosenthal does not teach this feature. Rather, Rosenthal teaches an anti-theft system designed to provide an alert in the event a first portable unit becomes separated from a second portable unit by more than a predetermined distance. In particular, Rosenthal teaches: “[t]his invention relates to an alarm system and method for generating an announcement with a speech synthesizer when portable first and second units

become separated by a predetermined distance.” (col 1, lines 8-11). Therefore, Rosenthal teaches one portable device emits an alarm to indicate it has been separated from a second portable device by more than a given distance. Accordingly, Applicant submits Rosenthal does not teach “said programmable device is configured to emit a user-sensible signal to indicate that said programmable device should be brought into communication with said receiving station.” In view of the above, Applicant submits the features of claim 1 are not taught or suggested by the cited art, either singly or in combination.

Still further, Applicant submits one would not be motivated to combine Rosenthal with Herz. Herz is directed to a television remote control. In contrast, Rosenthal is directed to an anti-theft device. Were one to combine Herz with Rosenthal, one would arrive at a mechanism to prevent theft of a television remote control. In particular, if the television remote control became separated from the second device (e.g., the television) by greater than a predetermined distance, an alarm would sound. However, Applicant submits that an alarm sounding whenever the remote control exceeded a particular distance from the television would be both annoying and undesirable. Accordingly, not only would the combination of Herz and Rosenthal not teach the features of the claimed invention, Applicant submits one would not be motivated to combine Rosenthal with Herz.

Further, Applicant submits Rosenthal is not within the field of Applicant’s endeavor and not reasonably pertinent to the particular problem with which the inventor was concerned because a person of ordinary skill, seeking to solve the problems addressed by Applicant’s claimed invention would not reasonably be expected or motivated to look to anti-theft devices. For example, in describing the prior art, Applicant’s description includes the following:

“These smart toys may be limited in their utility because they cannot be upgraded or because the procedures for upgrading or reprogramming the toy are too difficult for some users. A child, for example, may be unable to understand instructions for upgrading a toy. The child may not even be able to read the instructions. Further, even a child who can understand the instructions for upgrading the toy may not understand the procedures for using a personal computer to establish a connection to the manufacturer’s server. It may also be the case that the child does not have permission to do so. Still further, although it may be possible to reprogram the toy, it typically is not

possible to control the downloaded information and to filter the programming to select only that programming which is appropriate for a particular user.” (page 2, lines 4-14).

In stark contrast to the above, Rosenthal describes the prior art in the following manner:

“However, the systems of the prior art described herein do not provide for an alarm under the circumstances where, a traveling person who puts down his or her bag, looks up a moment too late to witness a thief making off with the bag. The traveling person, in this situation, has no way of calling attention to the thief as the theft is taking place nor knowing which direction the thief has gone in flight. Furthermore, the systems of the prior art do not speech synthesis means for announcing to the thief that the theft has been detected or other persons that the person carrying the stolen article is a thief.” (Rosenthal, col. 2, lines 26-37).

Accordingly, in view of the clear differences between the fields of endeavor between the present application and Rosenthal, Applicant submits one would not reasonably be expected or motivated to look to the field of anti-theft devices and Rosenthal is inapposite art. In view of the above discussion, Applicant submits each of claims 1, 12 and 23 are patentable over the cited art. Further, because each of the dependent claims include at least the features of the independent claims upon which they depend, each of dependent claims 2-3, 5-11, 13-22 and 24-31 are patentable as well.

In addition to the above, Applicant further submits the dependent claims include additional features which are neither taught nor suggested by the cited art. For example, claim 10 recites the feature “wherein said receiving station is configured to transmit instructional cues to said programmable device and wherein said programmable device is configured to provide said instructional cues to a user” which is not taught or suggested by the cited art. In paragraph 2 of the present Office Action, Herz is cited as teaching this feature. In particular, the Office Action states:

“Regarding claim 10, Herz further discloses, wherein the receiving station (TV set) is configured to transmit instructional cues to the programmable device (RC) and wherein the programmable device is configured to provide the instructional cues (i.e., text or graphic overlaid ... as defined by the Applicant description page 17, line 16) to a user (Col. 8, lines 44-Col. 9, lines 10 and Col. 11, lines 15-Col. 13, lines 20; Fig. 10B-12B).”

Applicant first notes that the recitation of claim 10 refers not just to any type of cue. Rather, claim 10 refers specifically to “instructional cues.” To better understand the context of claim 10, reference is made to the description wherein is describes a portion of the prior art as follows: “These smart toys may be limited in their utility because they cannot be upgraded or because the procedures for upgrading or reprogramming the toy are too difficult for some users. A child, for example, may be unable to understand instructions for upgrading a toy. The child may not even be able to read the instructions. Further, even a child who can understand the instructions for upgrading the toy may not understand the procedures for using a personal computer to establish a connection to the manufacturer's server.” (page 2, lines 4-13). The description then further includes:

“Smart toy 80 includes a speaker 86 for providing information to the user. Speaker 86 is coupled to bus 83 and may be driven by an interactive application executed by control unit 81 or by signals which are simply passed through the toy from receiver 85 to speaker 86. In the former instance, the interactive application may play pre-recorded words or phrases in response to signals generated by sensor 84. The application may even be configured to construct simple sentences. In the second case, which may be referred to as streaming audio, speech data may be passed through the toy in order to provide instructions or other detailed information to the user without the need for large amounts of memory. In other words, the audio data is not stored and replayed, but is instead received by the toy and conveyed immediately to speaker 86 (or possibly to an amplifier). Any audio buffering which may be necessary can be performed by the receiver before the data is transferred to the toy. This feature may be useful, for instance, when a child is attempting to download information to a toy and needs verbal cues to assist him or her in performing this task.” (page 9, lines 4-17).

“In one embodiment, a child brings the toy within programming range of the receiving station to establish the communications link between the toy and the receiving station. The receiving station transmits streaming speech data to the toy. The streaming speech data is received by the toy and conveyed to a speaker, where it is converted to audible speech. Thus, the speech data does not have to be stored in the toy. The audible speech may provide instructions to the child for completing a download to the toy.” (page 21, line 6-12).

In view of the above, it is apparent that the recited adjective “instructional” is not devoid of meaning. Accordingly, an instructional cue is, generally, a cue which pertains to, or promotes,

instruction or education. In contrast, Applicant respectfully submits that the teachings of Herz cited by the Examiner do not teach or suggest such instructional cues. For example, those portions of Herz cited as teaching this feature relate to: transmitting EPG data to the remote control (col 8., lines 44-52); EPG data may be stored and retrieved (col. 9, lines 2-26); the generation and resizing of a PIP window on the television using the remote control, etc. (cols. 11-13.) Applicant submits the recited feature is wholly absent from these teachings of Herz and the other cited art.

In addition to the above, because instructions cues are not taught by the cited art, the feature of claim 11 “wherein said instructional cues comprise streaming speech data” is not taught either.

#### Regarding Paragraphs 3 and 5

#### **The Goodman Patent is Not Prior Art**

In the present Office Action, claims 5-7 and 12-22 stand rejected under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,427,238 (hereinafter “Goodman”). However, Goodman is not prior art to the present application. The American Inventors Protection Act of 1999 amended 35 U.S.C. § 103(c) to state that art which qualifies as prior art only under § 102(e), (f) or (g) is not available for rejections under § 103 if that art and the subject matter of the application under examination were owned by or subject to an obligation of assignment to the same assignee at the time the invention was made. This change to 35 U.S.C. § 103(c) is effective for any application filed on or after November 29, 1999.

The present application is an application for patent filed after November 29, 1999. At the time the invention was made, the subject matter of present application and the Goodman patent were both owned by or subject to an obligation of assignment to the same assignee, OpenTV, as evidenced by the assignment for the present application recorded in the PTO at reel 10839, frame 0495, and the assignment for the Goodman patent recorded in the PTO at reel 9959, frame 0574.

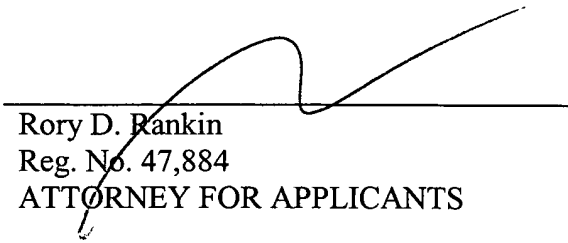
Therefore, the amendment to 35 U.S.C. § 103(c) made by the American Inventors Protection Act of 1999 applies to the present application and operates to exclude the Goodman patent as available prior art for rejections under 35 U.S.C. § 103. Accordingly, the rejections of claims 5-7 and 12-22 are moot.



## CONCLUSION

In light of the foregoing amendments and remarks, Applicant submits the application is now in condition for allowance, and an early notice to that effect is requested. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account No. 50-1505/5266-01702/RDR.

Respectfully submitted,



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Date: 11/6/03